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No. 98-753

IN THE
Supreme Court of the United States
OCTOBER TERM, 1998

EXXON CHEMICAL PATENTS, INC.,

Petitioner,

v.

THE DOW CHEMICAL COMPANY,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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RULE 29.6 STATEMENT

Pursuant to Rule 29.6, The Dow Chemical Company hereby states that it has no parent corporation and one nonwholly owned subsidiary that is publicly traded, Astropower, Inc.

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BRIEF IN OPPOSITION

As this Court has recognized, sometimes district court orders remanding a case to an administrative agency are immediately appealable, and sometimes they are not. *See, e.g., Sullivan v. Finkelstein*, 496 U.S. 617, 623 (1990). To determine whether a particular remand order is appealable, courts look to well-established factors, including (1) whether the relevant statutory scheme authorizes appellate review in that procedural posture, and (2) whether the case involves an important legal issue that might be effectively unreviewable after remand. Courts apply these factors in light of the general principle that piecemeal appeals are not favored, and that the preferable option is to have the entire case on appeal upon the conclusion of all proceedings below. *See, e.g., Firestone Tire & Rubber Co. v. Risjord*, 449 U.S. 368, 373-74 (1981).

The petition for *certiorari* here involves nothing more than the application of these settled legal principles to routine facts. Doing so below, the Federal Circuit concluded that Exxon's

appeal was premature in light of the particular facts and circumstances of this case. Exxon's herculean efforts to conjure up a legal conflict between that decision and decisions of this Court and other courts are futile. Accordingly, the petition should be denied.

COUNTERSTATEMENT OF THE CASE

The dispute underlying this appeal is an interference proceeding between Exxon and Dow involving the patents for a new class of polyethylene polymers. *See* Pet. App. 10a. In December 1995, the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office entered judgment against Dow on the basis of a new procedural rule, 37 C.F.R. § 1.662(b). *See id.* at 30a-32a.

Dow then filed this action to review the Board's decision pursuant to 35 U.S.C. § 146. *See* Pet. App. 56a-60a. The District Court (Robinson, J., D. Del.) entered summary judgment in Dow's favor, holding that the Board had erred by relying on its new procedural rule without first notifying the parties. *See id.* at 26a-27a. The District Court accordingly vacated the Board's judgment and remanded the case for further proceedings. *See id.* at 28a-29a.

Exxon appealed to the Federal Circuit pursuant to 28 U.S.C. § 1295(a)(4)(C). Before responding to the merits of the appeal, Dow moved to dismiss for lack of appellate jurisdiction. After full briefing on the jurisdictional issue, the Federal Circuit (in an unpublished opinion) granted the motion. *See* Pet. App. 1a-5a.

The Federal Circuit began by reciting the general rule that an order or decision is final and appealable "if it 'ends the litigation on the merits and leaves nothing for the court to do but execute judgment.'" Pet. App. 2a (quoting *Firestone,* 449 U.S. at 373). The Court then noted that an order remanding a case to an administrative agency may be final and appealable under certain circumstances. Thus, the Court noted, a remand order is obviously appealable where a "specific statute" so

provides. Pet. App. 4a. In addition, the Court observed, an order may be appealable if it resolves "an important issue that may be effectively unreviewable at a later stage in the proceedings." *Id.* at 3a (citing, *inter alia, Finkelstein*, 496 U.S. at 625).

Applying these considerations, the Federal Circuit determined that the remand order at issue here was not ripe for appeal. The Court emphasized that (in contrast to other administrative schemes) "no specific statute" authorized appeals of remand orders in patent interference cases. Pet. App. 3a-4a. The Court also pointed out that all the issues in this case could be "reviewed, if necessary, following remand." *Id.* at 5a. Finally, the Court rejected Exxon's alternative argument that the remand order (even if not immediately appealable as of right) should be reviewed by writ of mandamus. *See id.*

Exxon subsequently filed a motion for reconsideration and a suggestion for reconsideration *in banc*, which were denied on August 13, 1998, and August 25, 1998, respectively. *See* Pet. App. 37a-40a.

REASONS FOR DENYING THE WRIT

As the Federal Circuit correctly recognized, the appealability of remand orders is intensely context-specific. Under the particular circumstances of this case, Exxon failed to identify any factual or legal considerations to overcome the traditional presumption against piecemeal appeals.

Exxon challenges each of two factors cited by the Federal Circuit in support of its conclusion that the remand order here was not immediately appealable. *First,* Exxon asserts that the Federal Circuit's consideration of whether the legal issues could be reviewed in a post-remand appeal is "squarely contradicted" by this Court's decision last Term in *Forney v. Apfel*, 118 S. Ct. 1984 (1998). Pet. 3, 7. *Second,* Exxon argues that the decision below creates a circuit conflict on whether a

remand order is appealable in the absence of a "specific statute" authorizing an appeal. *Id.* at 8-11.

Exxon is wrong on both counts.

I. THE DECISION BELOW IS ENTIRELY CONSISTENT WITH *FORNEY*.

Exxon's opening salvo—that the decision below is "squarely contradicted" by *Forney*—falls far wide of the mark. The issue in *Forney* was whether the Ninth Circuit had erred in holding a remand order unappealable in the Social Security disability context. The *Forney* Court began by emphasizing that the relevant text of the Social Security Act "means what it says, namely, that a district court order remanding a Social Security disability benefit claim to the agency for further proceedings is a 'final judgment' for purposes of [28 U.S.C.] § 1291 and it is, therefore, appealable." 118 S. Ct. at 1986-87 (citing *Finkelstein*, 496 U.S. 617).

The *Forney* Court went on to consider whether *Finkelstein* was nonetheless inapposite to that case. The Court noted some distinctions between the two cases, including the fact that (1) the Government was the appellant in *Finkelstein*, and (2) the possibility that post-remand appellate review might have been impossible in *Finkelstein*. *See* 118 S. Ct. at 1987. The Court, however, concluded that these distinctions were "irrelevant" in light of the express language of the Social Security Act. *Id.* The Court specifically rejected the notion that *Finkelstein* applied only in cases where the Government was the appellant or post-remand appellate review might be impossible. *Id.*

Nothing in *Forney* remotely contradicts the Federal Circuit's decision in this case. Contrary to Exxon's suggestion, *Forney* did not hold that the availability (or lack of availability) of post-remand appellate review is *never* relevant in evaluating the appealability of a remand order. Rather, the *Forney* Court simply noted that, in the Social Security disability context, the appealability of remand orders is not *limited* to situations where an important legal issue might escape review after

remand. *Forney* in no way suggests that all remand orders in all contexts are immediately appealable even where (as here) all issues can be resolved in a single post-remand appeal.

Moreover, Exxon's request for this Court to grant the petition, vacate the judgment, and remand to the Federal Circuit in light of *Forney* is untenable on equitable as well as substantive grounds. This Court issued its decision in *Forney* over three weeks *before* the Federal Circuit issued its decision in this case. Accordingly, there was ample time for Exxon—surely a sophisticated litigant with able counsel—to bring that decision to the Federal Circuit's attention. Exxon not only failed to do so, but also failed to mention *Forney* in its subsequent motion for reconsideration and suggestion for reconsideration *in banc*. This Court should not exercise its extraordinary "GVR" power to grant Exxon another opportunity to cite a case it could have cited previously in the Federal Circuit, and which in any event has no bearing here. *Cf. Lawrence v. Chater*, 516 U.S. 163, 173 (1996) (*per curiam*) (emphasizing that GVR power "should be exercised sparingly").

II. THE DECISION BELOW IS ENTIRELY CONSISTENT WITH DECISIONS FROM OTHER COURTS OF APPEALS.

Exxon's attempt to conjure up a conflict among the circuits rests on the fanciful proposition that the Federal Circuit held below that remand orders are never appealable unless "the statute conferring district court jurisdiction expressly provides for appealability" of such orders. Pet. 8-9; *see also id.* at i (alleging circuit conflict on appealability of remand order "when, as here, the statute conferring jurisdiction on the district court does not expressly provide for appealability"). Because the Federal Circuit held nothing of the kind, the conflict alleged is wholly illusory.

The Federal Circuit simply made the obvious point that a remand order may be appealable if a "specific statute" so provides, even if the order otherwise would not have been

appealable under general finality principles. Pet. App. 4a. The Social Security cases (like *Forney* and *Finkelstein*) fall into this category, as the appealability of Social Security remand orders is specifically addressed in the relevant statute. *See Forney*, 118 S. Ct. at 1986-87; *Finkelstein*, 496 U.S. at 625. As the Federal Circuit noted (and Exxon concedes), no "specific statute" governs appealability in this case. Accordingly, resort to general finality principles here is necessary and appropriate. The Federal Circuit in no way held or suggested that the remand order in this case was *per se* unappealable because not specifically authorized by statute. Indeed, Exxon's interpretation of the decision below makes no sense, as there would have been no reason for the Federal Circuit to address general finality principles (such as the unreviewability point discussed above) if the absence of specific statutory authorization were dispositive. The circuit conflict alleged by Exxon, in short, does not exist.

CONCLUSION

For the foregoing reasons, the petition for a writ of *certiorari* should be denied.

Respectfully submitted,

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